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2-6-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: )  
John Eckl. ) Attorney Docket No.: F-278  
Serial No.: N/A ) Group Art Unit: 2767  
Filed: herewith )

For: BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION

DECLARATION UNDER 37 CFR §1.131

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

I, Lawrence E. Sklar declare as follows:

1. I was the Pitney Bowes Inc. patent attorney responsible for drafting and filing the United States patent application serial number 08/772,293, originally titled "Inserter Billing System With Electronic Distribution," (the "293 application"), which I understand to be the parent of the present application. The inventor for the '293 application was John Eckl, an employee of Pitney Bowes' Production Mail business unit.

2. The '293 application was filed on December 23, 1996. In this declaration, I will describe documentation and events demonstrating an earlier conception of the invention, and the subsequent continuous activities leading to the drafting and filing of the '293 application.

3. Prior to January 11, 1996, John Eckl prepared and submitted to the Intellectual Property and Technology Law Department of Pitney Bowes Inc. an invention disclosure describing an embodiment of the invention in the '293 application. A copy of the invention disclosure is attached hereto as Exhibit A. The invention disclosure was received by the Intellectual Property and Technology Law Department of Pitney Bowes Inc. on July 12, 1995 and was docketed for handling by the Intellectual Property and Technology Law Department in due course.

4. In early September, 1995, in accordance with the standard procedures of the Intellectual Property and Technology Law Department of Pitney Bowes Inc., a novelty search relating to the invention disclosure was conducted at the United States Patent and Trademark Office. As a result of the search various references were gathered and evaluated.

5. In 1996, I was responsible for intellectual property matters for the Production Mail business unit at Pitney Bowes. At that time, Production Mail was a large, self-contained, business unit having its own development and manufacturing facilities in Danbury, Connecticut and employing approximately 1,000 employees. Among the matters that I handled for the Production Mail business unit was John Eckl's invention disclosure. During 1996, for the Production Mail business unit, I was also responsible for evaluating new invention disclosures, prosecuting pending patent applications, supporting intellectual property and technology transactions and agreements, and reviewing products to ensure that new products did not infringe others' intellectual property. During 1996, I was responsible for negotiating a major, company-wide, software technology agreement worth millions of dollars for Pitney Bowes' infrastructure and supply chain management. During 1996 I was also responsible for company-wide trademark and copyright matters.

6. Pursuant to Pitney Bowes procedures, the Eckl invention disclosure and other invention disclosures were evaluated and discussed at regularly scheduled meetings of the Pitney Bowes Production Mail internal Patent Committee. The first meeting was in February of 1996. All disclosures were addressed in due course pursuant to standard investigation procedures, and were subsequently evaluated on the basis of their technical and business merits. At the February 1996 meeting it was decided to proceed with further evaluation and investigation of the Eckl invention. After a June 1996 meeting, a decision was made to proceed with preparing and filing a United States patent application based on the Eckl invention disclosure.

7. Pursuant to my ongoing investigation and drafting of the patent application for the Eckl invention disclosure, I sent a memorandum, dated August 6, 1996, asking John Eckl to consider U.S. Patent Nos. 4,941,091 and 5,283,829 with respect to his invention. A copy of the August 6, 1996 memorandum is attached hereto as Exhibit B.

8. After sending the August 6 memorandum to John Eckl, I remained in regular contact with him to discuss issues relating to the patent application. As can be seen on Exhibit B, I made handwritten notes dated August 8, 23, 27, and 29 and September 10 and 12 indicating various phone conversations that I had with John Eckl.

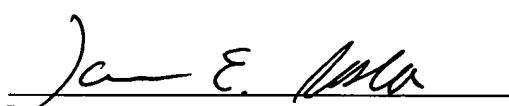
9. At my request, John Eckl also prepared a drawing of the invention which he completed on October 25, 1996 and a further narrative description of the invention which he forwarded to me on November 11, 1996. A copy of the October 25 drawing and November 11, 1996 memorandum are attached hereto as Exhibit C.

10. By memorandum dated November 20, 1996, I forwarded a draft of a patent application to John Eckl for review and comment. A copy of the November 20, 1996 memorandum is attached hereto as Exhibit D.

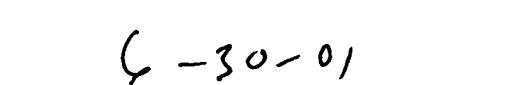
11. On December 6, 1996, John Eckl faxed (i) a mark-up of a claim of the draft patent application, and (ii) an addition to page 1 of the specification of the draft patent application. A redacted copy of the facsimile message is attached hereto as Exhibit E.

12. It is my belief that, from prior to January 11, 1996 until December 23, 1996, John Eckl, the Pitney Bowes Intellectual Property and Technology Law department, and myself worked diligently and reasonably toward the filing the '293 patent application in due course under the circumstances described herein.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Lawrence E. Sklar



Date

<b>DECLARATION AND POWER OF ATTORNEY</b> Patent Application	Attorney's Docket Number E-546
	Page 1 of 2

As below named inventor, I hereby declare that:

my residence, post office address and citizenship are as stated below next to my name;

I believe that I am the original, first and sole inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled

**INSERTER BILLING SYSTEM WITH ELECTRONIC DISTRIBUTION**

described and claimed in the attached specification; I have reviewed and understand the contents of the above-identified specification, including the claims;

I acknowledge my duty to disclose to the Patent and Trademark Office all information known to me to be material to the patentability of this application as defined in Title 37, Code of Federal Regulations, section 1.56; and

I do not know and do not believe the invention was ever known or used in the United States of America before my invention thereof, or patented or described in any printed publication in any country before my invention thereof or more than one year prior to this application, that the invention was not in public use or on sale in the United States of America more than one year prior to this application, that the invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to this application, and that no application for patent or inventor's certificate on this invention has been filed in any country foreign to the United States of America prior to this application by me or my legal representatives or assigns.

I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith;

Lawrence E. Sklar	Reg. No. 25,924
Melvin J. Scolnick	Reg. No. 25,233
David E. Pitchenik	Reg. No. 24,020
Robert E. Meyer	Reg. No. 26,307

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<b>DECLARATION AND POWER OF ATTORNEY</b> <b>Patent Application</b>		<b>Attorney's Docket</b> <b>Number</b> <b>E-546</b> <b>Page 2 of 2</b>		
<p>Address all telephone calls to Lawrence E. Sklar at telephone No.: (203) 924-3882.</p> <p>Address all correspondence to: Lawrence E. Sklar Pitney Bowes Inc. Intellectual Property and Technology Law Department 35 Waterview Drive P.O. Box 3000 Shelton, CT 06484</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p>				
<b>FULL NAME</b>	Last Eckl	First John	Middle Initial K.	
<b>Residence &amp; Citizenship</b>	City Brookfield		State CT	Citizenship USA
<b>Post Office Address</b>	Street Address 150 North Lakeshore Drive	City Brookfield	State CT	Zip Code 06804
<b>Signature of Inventor</b>			<b>Date</b>	
<i>John K. Eckl</i>			8/17/86	

ASSIGNMENT

WHEREAS, I, John K. Eckl have invented certain new and useful improvements in a **INSERTER BILLING SYSTEM WITH ELECTRONIC DISTRIBUTION** identified as File Number E-546 in the Intellectual Property and Technology Law Department files of the hereinafter-mentioned assignee, and have executed an application for United States Patent based thereon on the 17/12/96 day of December, 1996;

AND WHEREAS, Pitney Bowes Inc., a corporation organized and existing under the laws of the State of Delaware and having its place of business at World Headquarters, Stamford, Connecticut, U.S.A., is desirous of acquiring certain rights thereunder.

NOW, THEREFORE, for one dollar and other good and valuable consideration, receipt of all of which is hereby acknowledged, I have agreed to and hereby sell, assign and transfer unto said corporation the entire right, title and interest, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto, in and to said invention, said application and any and all patents (including extensions thereof, and all the rights under the International Convention for the Protection of Industrial Property including the right to claim for any foreign patent application the priority date of the corresponding U.S. patent application) of any country, which have been or may be granted on said invention or any part thereof, or on said application or any divisional, continuing, renewal, substitute, reissue or other patent application based in whole or in part thereon, or based upon said invention;

TO BE HELD AND ENJOYED by said corporation, its successors and assigns, to the full ends of the respective terms of which said patents or any of them have been or may be granted, as fully and entirely as the same would have been held and enjoyed by me had no sale and assignment of said interest been made;

AND I do hereby authorize and request the Commissioner of Patents and Trademarks of the United States of America to issue any and all United States patents which may be granted upon said United States application or any of them, or upon said invention or any part thereof, to said corporation;

AND I hereby agree for myself and for my heirs, executors and administrators, to execute without further consideration any further lawful documents and any further assurances, and any divisional, continuing, renewal, substitute, reissue, or other applications for patents of any country, that may be deemed necessary by said corporation fully to secure to said corporation, its interest as aforesaid in and to said invention or any part thereof, and in and to said several patents or any of them;

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AND I do hereby covenant for myself and my legal representatives and agree with said corporation, its successors and assigns, that I have granted no right or license to make, use or sell said invention to anyone except said corporation, that, prior to the execution of this deed, my right, title and interest in said invention had not been otherwise encumbered, and that I have not executed and will not execute any instrument in conflict herewith.

IN WITNESS WHEREOF, I have hereunto set my hand and affixed my seal:

John K. Eckl 2/17/96  
John K. Eckl Date

ACKNOWLEDGMENT

State of Connecticut ) ss. *Donbury*  
County of Fairfield )

On this 17<sup>th</sup> day of December, 1996, personally appeared before me the above-named John K. Eckl to me known and known by me to be the person described in and who executed the foregoing instrument, and subscribed the same in my presence, and acknowledged the same to be his/her free act and deed in and for the purposes set forth in said instrument.

Denise Hayes  
NOTARY PUBLIC

DENISE A. HAYES  
NOTARY PUBLIC  
MY COMMISSION EXPIRES MAY 31, 2000